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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,161	08/10/2006	Ulrich Peuchert	3811	6875
7590	04/04/2008		EXAMINER	
Striker Striker and Stenby 103 East Neck Road Huntington, NY 11743			JOHNSON, KEVIN M	
			ART UNIT	PAPER NUMBER
			1793	
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			04/04/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/589,161	<b>Applicant(s)</b> PEUCHERT ET AL.
	<b>Examiner</b> KEVIN M. JOHNSON	<b>Art Unit</b> 1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 05 February 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 38-80 is/are pending in the application.

4a) Of the above claim(s) 51-80 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 38-50 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/0250) \_\_\_\_\_  
 Paper No(s)/Mail Date 8/10/2006

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

**10/589161**

**DETAILED ACTION**

***Status***

1. Claims 1-37 are cancelled, and new claims 38-80 are pending and presented for examination.

***Election/Restrictions***

2. Applicant's election with traverse of the Group I glass composition, new claims 38-50, in the reply filed on 2/5/2008 is acknowledged. The traversal is on the ground(s) that the new claims have a common technical distinguishing feature that distinguishes them from the prior art. This is not found persuasive because the core glass taught by Chu does not require either B<sub>2</sub>O<sub>3</sub> or Al<sub>2</sub>O<sub>3</sub>, and therefore the new common technical feature of the glass being free of B<sub>2</sub>O<sub>3</sub> or Al<sub>2</sub>O<sub>3</sub> is not distinguished from the prior art.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 51-80 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2/5/2008.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 38, 39, 42 and 49 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claimed glass compositions contain at least 75 mol-% silica, and can therefore not contain more than 25 mol-% of other constituents. The upper limits for the Yb<sub>2</sub>O<sub>3</sub> and ZrO<sub>2</sub> content can therefore not be more than 25 mol-%. For the purposes of examination the upper limits for the Yb<sub>2</sub>O<sub>3</sub> and ZrO<sub>2</sub> content is interpreted to be 25 mol-%.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 38-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chu et al. (US 6128430).

In regards to claims 38-47, Chu teaches a glass composition consisting essentially of 0-90 mol-% SiO<sub>2</sub>, 0-5 mol-% Yb<sub>2</sub>O<sub>3</sub>, 0-2 mol-% ZrO<sub>2</sub>, 0-40 mol-% Al<sub>2</sub>O<sub>3</sub>, 0-15 mol-% B<sub>2</sub>O<sub>3</sub>, and 0.001-5 mol-% Er<sub>2</sub>O<sub>3</sub> in addition to other non-required components. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected from the overlapping portion of the ranges disclosed by the reference because overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05. It would have been further obvious to one skilled in the art that a glass selected from the overlapping ranges would have been x-ray opaque.

In regards to claim 48, it would have been obvious to one skilled in the art at the time of the invention that the Yb<sub>2</sub>O<sub>3</sub> suggested by Chu could be substituted for the Er<sub>2</sub>O<sub>3</sub> required by the composition, as they are both rare earth oxides. This would allow the selection of a glass composition that contains only three oxide ingredients and meets all the requirements of the instant claims.

10. Claims 49 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chu in view of Kunert et al. (US 6297181).

In regards to claim 49, Kunert teaches that a glass may be converted by a known manner such as grinding and sieving to a powder with a mean particle size of less than 10 microns (column 7, lines 9-13). It would be obvious to one skilled in the art that the glass composition taught by Chu could be subjected to such a process. This modification would be motivated by the suggestion in Kunert that glass powders have added functionalities, for instance their use in dental composites.

In regards to claim 50, Kunert teaches that glass powders are commonly silanized to promote greater performance (column 7, lines 24-28).

### ***Conclusion***

11. All claims are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN M. JOHNSON whose telephone number is (571)270-3584. The examiner can normally be reached on Monday-Friday 7:30 AM to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jerry A Lorengo/  
Supervisory Patent Examiner, Art Unit 1793

KMJ